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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/009,287

11/06/2001

Reinhard Janka

GK-ZEI-3140

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7590

05/08/2007

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

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NEW YORK, NY 10022-7650

EXAMINER

GAKH, YELENA G

ART UNIT

PAPER NUMBER

1743

MAIL DATE

DELIVERY MODE

05/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/009,287

Applicant(s)

JANKA ET AL.

Examiner

Yelena G. Gakh, Ph.D.

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 15-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. RCE and Amendment filed on 03/19/07 is acknowledged. Claims 12, 15-19 and 21-23 are pending in the application. Claims 19 and 21-23 are withdrawn from consideration as being directed to a non-elected invention. Claims 12 and 15-18 are examined on merits.

Response to Amendment

2. All rejections of the pending claims are sustained.

Information Disclosure Statement

3. The examiner respectfully requests the Applicants to provide a highly pertinent disclosure of Carl Zeiss' device combining ConfoCor 2 and LSM (laser scanning microscope), which became available to the public in 2000.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites "a device unit for analyzing molecular interactions in small volumes". It is not clear, which specific "a device" that is capable of analyzing molecular interactions is meant in the claim? While at the end the claim recites that the computer performs analysis of molecular interactions based on fluorescence correlation spectroscopy (FCS) and the unit for imaging, such recitation is in discrepancy with a very broad definition of the "a device unit for analyzing the molecular interactions". If there are many devices capable of providing data for performing FCS, the examiner is not aware of them. If there is one particular device, which is capable of providing such data, which is a fluorescence correlation spectroscopy, it should be

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explicitly recited in the claim. Otherwise the claim recites a contradictory subject matter and is rendered unclear and indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 12 and 15-18** are rejected under 35 U.S.C. 102(b) as being anticipated by Carl Zeiss' device combining ConfoCor 2 and LSM (laser scanning microscope) (2000), referred to by Weisshart et al. (Current Pharmaceutical Biotechnology, 2004).

Weisshart describes device disclosed by Carl Zeiss in 2000, which is a combination of a two-channel fluorescence correlation spectroscopy (ConfoCor 2), which has a two-channel detection system and thus is capable of measuring cross-correlation, and laser scanning microscope (LSM). According to Weisshart's description of this device, it totally corresponds to the device recited in claims 12 and 15-18.

Response to Arguments

8. Applicant's arguments filed 03/19/07 have been fully considered but they are not persuasive. The Applicants' arguments may be considered non-responsive, since the examiner did not find any response to the rejections established in the previous Office action; the Applicants did not provide any arguments demonstrating non-anticipation of the instant invention by the prior art. The examiner specifically requested the applicants to provide "their arguments directed to a clear and unambiguous differentiation between the claimed invention and the device. If the claims will be accordingly amended and the differences are clearly indicated, the examiner will rejoin the apparatus and method claims, when the method claims will be amended correspondingly to allowable apparatus claims". The Applicants' statement that

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Carl Zeiss is not the prior art to the instant application without any evidence provided by the applicants, as to why Zeiss is not the prior art, is not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5/02/07


YELENA GAKH
PRIMARY EXAMINER